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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,264	02/21/2002	Anthony John Hayton	J318-091 US	9835
21706	7590	10/06/2004	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			NAGPAUL, JYOTI	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/081,264	HAYTON ET AL.
	Examiner Jyoti Nagpaul	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-6,8 and 12** are rejected under 35 U.S.C. 102(b) as being anticipated by Beall.

Beall discloses a swab assembly capable of storing and transporting samples.

The applicator includes an outer housing (10) and an inner hollow tubular member (20).

The outer housing is formed in two interengageable housing parts. (32,12) The hollow tubular member is nonreleasably secured to one housing part for ease of handling.

(See Figure 5) The hollow tubular member includes a swab material (36) attached to one end and a seal (32) provided at another end. The inner tubular member is formed of plastic material. (Col. 2 Lines 21-23) The swab material is made of cotton. (Col. 2, Lines 35-36) A predetermined quantity of a reagent is held in tubular member between swab material and sealed by capillary action. (Col. 4, Lines 32-36; Col. 4 Line 60- Col. 5 Line 10) The inner hollow tube is adapted to be frangible adjacent to seal. The seal

comprises a crimping in the tubular membrane. The external housing is formed of resiliently deformable material. The frangible part of tubular member (20) can be fractured by deformation thus allowing reagent to flow onto swab material. (See Figure

2) The frangible part (36) is formed as an area of reduced thickness as compared to the remainder of the tubular member (12). (See Figure 2)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 7 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Beall in view of Joslin.

Beal fails to disclose the swab material is made of sponge material and the seal is made of wax or silicon.

Joslin discloses a specimen collecting and transporting device with an absorbent tip made of sponge material. (Col. 4, Lines 66-69) Joslin further discloses the seal may be adhesively secured in place. Joslin does not specifically disclose wax however wax is a type of adhesive. (Col. 2, Lines 67-68)

Thus, it would of have been obvious to one having ordinary skill in this art to modify the system of Beall to include the feature of Joslin such that the swab material is made of sponge material and the seal is adhesively secured in place, such as wax in order to ensure correct quantity of reagent is used and to ensure an airtight liquid barrier for proper flow of reagent onto swab material.

5. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Beall in view of Tobin.

Beall fails to disclose the diameter of the inner tubular member is in the range of 0.5 mm to 10.0 mm.

Tobin discloses a swab assembly with an inner tubular member where the diameter is approximately 1.4 mm. (Col. 2, Lines 46-49)

Thus, it would of have been obvious to one having ordinary skill in this art to modify the system of Beall to include the feature of Tobin such that the inner tubular member has a diameter of 1.4 mm in order to maintain a desired transport medium for

flow of reagent through the tube and to ensure that the correct quantity of reagent is used in the process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN


Jill Warden
Supervisory Patent Examiner
Technology Center 1700